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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/267,489	03/11/1999	JAY S. WALKER	WD2-98-092	7106

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EXAMINER

REAGAN, JAMES A

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 12/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/267,489

Applicant(s)

WALKER ET AL.

Examiner

James A. Reagan

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. This action is in response to the Request for Continued Examination (RCE) received on 07 November 2002.
2. Claims 1-50 have been examined.

Specification

3. The disclosure was objected to because it contains an embedded hyperlink and/or other form of browser-executable code. The examiner thanks the Applicant for deleting the embedded hyperlink. The objection is hereby withdrawn.

RESPONSE TO ARGUMENTS

4. Applicant's arguments with respect to claims 1-50 have been considered but are moot in view of the new ground(s) of rejection. However, in an effort to elucidate the applicability of the selected prior art, the Examiner has provided a riposte to the Applicant's arguments.

Applicant asserts:

- (1) *sending, for each postal mailing list in the plurality of postal mailing lists, an email message to each of a subset of list members "* (emphasis added)

AND

(2) *"selecting for use, based on the responses received in the previous step, one of the plurality of postal mailing lists", (emphasis added).*

With regard to (1), the Examiner has amended the rejections of the claim as shown below.

With regard to (2), the Examiner maintains that selection of the most accurate, most valuable, and most recent mailing lists is obvious to any organization that intends to increase profitability by direct or electronic mailing to selected recipients. In the Amendment and Response (paper #17), Applicant admits "...selecting a postal mailing list from a plurality of postal mailing lists is know" (page 7). Applicant goes on to state that selecting the list based on responses from emails is not shown. However, Applicant then implies that selecting postal mailing lists based on response rates, which are "limited and stale", is not an attractive choice. This lends support the position of the Examiner that it is not only obvious but also inherent to the profitable company to select mailing lists that are current and verified. On the bottom on page 8, Applicant discloses that Druckenmiller is concerned with creating e-mail mailing lists that are likely to have a high response rate. This also supports the position of the Examiner that effective mailing lists are more valuable than old, untested lists.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Examiner's note: Examiner has pointed out particular references contained in the prior art of record in the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the *entire* reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

6. Claims 1, 5-12, 14, 18-25, 27, 31-39, and 43-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Druckenmiller et al (US 6,167,435) in view of "How to Generate Online Leads from the Web" (Interactive Marketing News; 10 May 1996).

Claims 1, 27, and 39:

Sending an automated verification email message to the mailing list member and receiving a response from the member (column 2, lines 10-19).

Selecting a mailing list from a plurality of mailing lists according to a demographic, product, service, or other relevant subject (column 1, lines 14-15, column 3, lines 4-13 and lines 55-61).

Druckenmiller does not specifically disclose a postal mailing address. However, using a postal address as a correlation to an email address is an obvious choice relative to a demographic profile. In the specification, applicant states, "the subset of list members...can be selected with an eye toward various factors such as the demographics of the particular members, because the postal mailing lists are already compiled based on such factors." Druckenmiller, in column 7, lines 18-22 discloses, "demographic information for the subscribers may also be contained within each mailing list. Such demographic information may then be used to select only specific subscribers to a list according to various requirements." It would have been obvious to one of ordinary skill in the art at the time of the invention to use the demographic of a postal mailing address as a selection device for identifying possible mail recipients. Using a postal mailing address geographically identifies a target audience, and is already a well known practice in the targeted marketing practices.

In addition, Druckenmiller does not specifically disclose sending an email message to the member on the list. However, "How to generate Online Leads from the Web" discloses using postal address mailing lists, sending a questionnaire that includes postal mailing address fields and email address fields, asking recipients to submit their email address, and if they would like to be

added to the mailing list. Naturally, if a recipient responds with correct or updated contact information, either by email or by postal mail, the recipient can be regarded as a verified lead. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the invention of Druckenmiller with "How to generate Online Leads from the Web" because using email to verify postal addresses and to further target recipients provides good leads and increases potential profitability.

Claim 14:

The limitations of Claim 14 are of the same scope as the limitations of Claim 1, and are therefore rejected on the same basis, with the following noted exceptions. Claim 14 recites a processor, database, communication port, and a memory. Druckenmiller discloses a computer and a database in Figure 1.

Claims 5, 18, 31, and 43:

An email message is sent to each member of the mailing list. The content of each email is individualized and differs from the others by the email address and token identifier tailored to each subscriber (column 3, lines 34-45 and Figure 3).

Claims 6, 19, 32, and 44:

Storing the data concerning the member, such as subscriber information from the subscription form (column 6, lines 42-50).

Claims 7, 20, 33, and 45:

Selected topics are imbedded into the email to determine the content of the mailing list the member is to be associated with (column 3, lines 55-61).

Claims 8, 35, and 47:

A test identifier i.e. token (column 5, lines 17-20), a member identifier i.e. email address (column 5, line 2), creating and retrieving the test record, and updating the record based on member response (column 5, lines 34-54).

Claims 9, 36, and 48:

Questions in the form of topics of interest and the answers and other demographic data are submitted to the mailing list database (column 3, lines 4-13).

Claims 10, 37, and 49:

Mailing list selection based on the answers to the demographic/topic of interest questions (column 6, lines 34-42).

Claims 11, 21, 34, 38, 46, and 50:

Indicating the importance of a maximized response rate (column 8, lines 19-32). Inherently, selection of mailing lists that provide positive proof of increased and voluntary participation by the members on the mailing list are more valuable than lists which have old, untested, or unresponsive members. In addition, mailing lists with low response rates are considered less than ideal (column 1, lines 14-23), versus mailing lists with greater response rates, which are inherently more valuable to the organization attempting to profit from the list

(column 1, lines 40-41). Also, it is inherent to the development of evaluating the usefulness of a mailing list by its response rate to calculate and determine a quantitative or qualitative grade of the rate of member response. Furthermore, when selecting a mailing list for deployment, response rate is an inherent factor.

Claims 12:

Response to the message is made through a URL (column 2, lines 16-19).

Claim 22:

A test identifier i.e. token (column 5, lines 17-20), a member identifier i.e. email address (column 5, line 2), creating and retrieving the test record, and updating the record based on member response (column 5, lines 34-54).

Claim 23:

Questions in the form of topics of interest and the answers and other demographic data are submitted to the mailing list database (column 3, lines 4-13).

Claim 24:

Indicating the importance of a maximized response rate (column 8, lines 19-32). Inherently, selection of mailing lists that provide positive proof of increased and voluntary participation by the members on the mailing list are more valuable than lists which have old, untested, or unresponsive members. In addition, mailing lists with low response rates are considered less than ideal (column 1, lines 14-23), versus mailing lists with greater response rates, which are inherently more valuable to the organization attempting to profit from the list

(column 1, lines 40-41). Also, it is inherent to the development of evaluating the usefulness of a mailing list by its response rate to calculate and determine a quantitative or qualitative grade of the rate of member response. Furthermore, when selecting a mailing list for deployment, response rate is an inherent factor.

Claim 25:

Response to the message is made through a URL (column 2, lines 16-19).

7. Claims 2-4, 15-17, 28-30, and 40-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Druckenmiller in view of "How to Generate Online Leads from the Web" (Interactive Marketing News; 10 May 1996), in view of Applicant's own admission.

Claims 2, 15, 28, and 40:

Shown above, Druckenmiller discloses the subscription verification method as disclosed in the rejections of Claims 1, 14, 27, and 39. Druckenmiller does not disclose selling the mailing lists. Applicant, however, on page 2, line 10 of the specification, discloses a business purchasing a mailing list, inherently disclosing that a mailing list is bought and sold as a marketable item. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the practice of creating a mailing list and then selling the mailing list because a reliable and accurate list of customer leads is a valuable asset, and acquiring such lists provides an opportunity to expand an organization's customer/client base, thereby generating potential growth.

Claims: 3, 16, 29, and 41:

Shown above, Druckenmiller discloses the subscription verification method as disclosed in the rejections of Claims 1, 14, 27, and 39. Druckenmiller does not disclose renting the mailing lists. Applicant, however, on page 2, lines 8-9 of the specification, discloses that a mailing list may be rented. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the practice of creating a mailing list and then renting the mailing list because a reliable and accurate list of customer leads is a valuable asset, and acquiring such lists provides an opportunity to expand an organization's customer/client base, thereby generating potential growth. Renting is an option to purchasing the list because the accuracy of the list may decrease after a period of time, driving the value of the list downward.

Claims 4, 17, 30, and 42:

Shown above, Druckenmiller discloses the subscription verification method as disclosed in the rejections of Claims 1, 14, 27, and 39. Druckenmiller does not disclose renting the mailing lists. Applicant, however, on page 1, line 29 to page 2, line 1 of the specification, discloses that a mailing list may be used to "mail promotional items such as brochures, advertisements, or sales offers to persons included in the list." It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the practice of creating a mailing list and then mailing items to members on the mailing list because a reliable and accurate list of customer leads is a valuable asset, and acquiring such lists

provides an opportunity to expand an organization's customer/client base, thereby generating potential growth. Directly mailing brochures, advertisements, or sales offers promotes reasonable expansion by selectively targeting individual and groups who may be interested in involving themselves with the organization.

8. Claims 13 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Druckenmiller in view of "How to Generate Online Leads from the Web" (Interactive Marketing News; 10 May 1996), in view of McEvoy et al., United States Patent Number 6,292,785, hereafter referred to as "McEvoy."

Claims 13 and 26:

Shown above, Druckenmiller discloses the subscription verification method as disclosed in the rejections of Claim 1. Druckenmiller does not disclose compensating list members with an incentive. McEvoy, however, in column 5, lines 13-27, discloses an incentive as one of many possible services of the marketing research campaign compiling a mailing list. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the practice of creating a mailing list and compensating members who join the list because a reliable and accurate list of customer leads is a valuable asset, and enticing members with an incentive is a proven and effective way to increase participation, thereby increasing the value of the mailing list.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **James A. Reagan** whose telephone number is **(703) 306-9131**. The examiner can normally be reached on Monday-Friday, 9:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **James Trammell** can be reached at (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 305-3900**.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

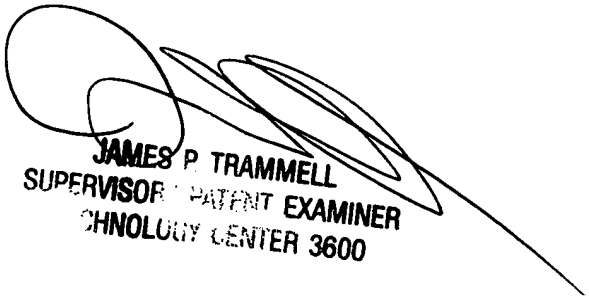
or faxed to:

(703) 305-7687	[Official communications; including After Final communications labeled "Box AF"]
(703) 308-1396	[Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

JAR

05 DECEMBER 2002


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